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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

031792-0311553

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on _____

Signature _____

Typed or printed name _____

Application Number

09/854,423

Filed

MAY 10, 2001

First Named Inventor

MICHAEL M. TSO

Art Unit

3693

Examiner

T. THAO HAVAN

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

applicant/inventor.

Signature

assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

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MARCH 2, 2009

Date

Registration number, if acting under 37 CFR 1.34 _____

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.



*Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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ATTACHMENT SHEETS TO PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop After-Final

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the Final Office Action mailed **September 30, 2008** (hereinafter "Final Action"), Appellant requests a review of the Final Action in the above-referenced application. This request is being filed concurrently with a Notice of Appeal. The review is requested for at least the reasons set forth below.

REJECTIONS UNDER 35 U.S.C. § 103

Review is requested for the rejection of each of the claims under 35 U.S.C. § 103(a) over U.S. Patent No. 6,061,660 to Eggleston in view of U.S. Patent No. 4,968,873 to Dethloff for *at least* the reason that the Examiner has failed to establish a *prima facie* case of obviousness. Assuming *arguendo* that it were legally proper to modify Eggleston to include the teachings of Dethloff in the manner alleged by the Examiner (which Appellant does not concede), the rejection would still be improper for at least the reason that neither Eggleston nor Dethloff, either alone or in combination, teach or suggest all the features of at least independent claims 1, 15, and 29.

The Examiner erroneously relies on Eggleston for the teachings of an intermediary. The Examiner has failed to establish that Eggleston discloses an intermediary as claimed. Assuming *arguendo*, that Eggleston teaches an intermediary (which is not conceded), Eggleston clearly fails to disclose at least the following features of claim 1 which further recite features of the intermediary:

receiving at an intermediary from a first participant in the transaction, a request to process the transaction using a *first currency that is not recognized by a second participant* in the transaction, wherein the first currency comprises a private currency;

decrementing, by the intermediary, an amount of the first currency associated with the first participant by decrementing a balance of a first currency account of the first participant, and *incrementing, by the intermediary*, an amount of second currency associated with the first participant by incrementing a balance of a second currency account of the first participant, wherein the second currency is recognized by the second participant;

I. Eggleston's telecommunications connection is not an intermediary.

The Examiner erroneously alleges that “[a]n intermediary as claimed corresponds to a telecommunications connections [38] in Eggleston since they are both a connection to link information between users.” [Final Action, pgs. 3-4]. This ignores the express recitations of the claims regarding what the intermediary does. The Examiner further refers to paragraph 21 of Appellant’s Specification to support his allegation. [Final Action, pg. 2].

Paragraph 21 of Appellant’s Specification recites:

Participant 202 is communicatively coupled to intermediary 206 *via a communications link 208*. Participant 204 is communicatively coupled to intermediary 206 *via a communications link 210*. Communications links 208, 210 may be implemented by any media or mechanism that provides for the exchange of data between participant 202 and intermediary 206 and between participant 204 and intermediary 206, respectively. Examples of communication links 208, 210 include, without limitation, any number of networks, such as Local Area Networks (LANs), Wide Area Networks (WANs), Ethernets or the Internet, or one or more terrestrial, satellite or wireless links.

The Examiner’s interpretation is legally flawed because it is clear the proper interpretation of the intermediary is not a communication link. Instead, it is clear that the intermediary is connected via communication links. Thus, Eggleston’s telecommunications connection 38 cannot properly be used to read on Appellant’s intermediary.

II. Eggleston does not disclose the claimed functions of the intermediary.

Even if the Examiner’s interpretation of the intermediary is assumed to be correct (though Appellant does not concede this), the Examiner clearly fails to consider the claim as a whole. Considered as a whole, the claim recites that the intermediary is used for: 1) receiving a request from a first participant in the transaction to process the transaction using a first

currency that is not recognized by a second participant in the transaction; 2) decrementing an amount of the first currency associated with the first participant by decrementing a balance of a first currency account of the first participant; and 3) incrementing an amount of second currency associated with the first participant by incrementing a balance of a second currency account of the first participant. Clearly, Eggleston's telecommunication connection 38 does not perform these claimed operations.

Dethloff is not relied upon nor does it overcome these deficiencies. Other arguments exist, but the foregoing arguments are clearly sufficient to demonstrate that the rejection of claim 1 is legally flawed and should be withdrawn.

Thus, for at least these reasons, Eggleston and Dethloff, either alone or in combination, fail to disclose, teach, or suggest at least the above-mentioned features of Appellants' claim 1. As such, the rejection of claim 1 is improper. Independent Claims 15 and 29 includes features similar to those set forth in claim 1 and is allowable for at least the same reasons given relative to claim 1. Thus, the rejection of these claims is likewise improper. The remaining pending claims depend from one of claims 1, 15 or 29 and are patentable at least by virtue of their dependencies as well as for their additional recitations.

For at least the foregoing reasons, the rejection is clearly improper and should not require an appeal.

Date: March 2, 2009

Respectfully submitted,

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